

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451

MBA

Mailed: June 30, 2009

Opposition No. 91094961
Opposition No. 91095203

Cancellation No. 92029390
Cancellation No. 92029476

Valentino U.S.A., Inc.

v.

Florence Fashions (Jersey)
Limited

Michael B. Adlin, Interlocutory Attorney:

These consolidated cases now come up for consideration of applicant/respondent's ("defendant") motion, filed May 19, 2009, for leave to file amended answers in each proceeding. Opposer/petitioner Valentino U.S.A., Inc. ("plaintiff") contests the motion.

Background

The pleadings are described in the Board's order of May 19, 2008, which denied plaintiff's motion for summary judgment. Additional background on the status and scheduling of these cases is included in the Board's subsequent orders of September 18 and December 15, 2008, and January 2 and April 24, 2009. As the parties are well aware, and the Board has repeatedly highlighted in these orders, these cases are quite old. In

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fact, the two opposition proceedings are now 15 years old, while the two cancellation proceedings are now 10 years old. Over one year ago, in its May 19, 2008 order, the Board indicated that given the age of these cases, no further extensions or suspensions would be granted. See also, Board's Order of October 20, 2006.

Defendant's Motion and Plaintiff's Response

Defendant seeks leave to amend its answers in each proceeding, primarily to add the following affirmative defense:

The pleaded common law marks are comprised of or contain the common surname VALENTINO. The pleaded marks are primarily merely a surname and lack distinctiveness. Opposer cannot establish that the pleaded marks acquired distinctiveness before Applicant's 1977 date of first use of its marks through its predecessor-in-interest or before the 1991 filing dates of Applicant's applications. Thus, Opposer cannot establish priority or proprietary rights in the marks.

In support of its motion, defendant claims that "[o]n the eve of the May 14, 2008 (sic)¹ testimony deposition of [defendant's] witness, James Norris, [defendant] made current counsel aware of ... its predecessor-in-interest's earlier date of first use in the United States in 1977." Defendant previously asserted a later date of first use. Defendant also claims that "on or about May 17, 2009, counsel for [defendant]

¹ The deposition was apparently conducted on May 14, 2009.

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discovered for the first time" an Office Action response submitted in connection with application Serial No. 79059290, which, according to defendant: (1) constitutes an admission by plaintiff "that the term VALENTINO is not inherently distinctive;" and (2) establishes that plaintiff "was clearly on notice that the VALENTINO mark is primarily merely a surname." Defendant contends that its motion was "promptly filed" after discovery of the relevant information, and "timely." Finally, defendant argues that plaintiff would not be prejudiced by the proposed amendments because plaintiff "has the several months before and its entire rebuttal period during which to address [defendant's] amended allegations and defense."

In opposing the motion, plaintiff claims that defendant's "delay in asserting its new affirmative defense was undue, and the timing of the motion would severely and unduly prejudice" plaintiff. Specifically, plaintiff points out that over one year ago, in its order of May 19, 2008, the Board held that "plaintiff, a licensee, may not rely on the presumptions accorded under Section 7(b) of the Trademark Act." Therefore, according to plaintiff, defendant has known for at least one year that plaintiff will be required to establish its priority date through evidence of use of its mark, and defendant should have long ago filed any motion to add an additional affirmative defense concerning priority. Plaintiff further points out that

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defendant successfully opposed plaintiff's November 10, 2008 motion to join and recaption, arguing at the time that plaintiff's motion was "untimely" in light of the May 19, 2008 order. Plaintiff argues that defendant's position now, seven months later, "is at best inconsistent." With respect to defendant's newly claimed date of first use in 1977, plaintiff alleges that this information was or at least should have been known much earlier.

In its reply brief, defendant primarily restates its original arguments, many of them several times. Defendant also argues that the proposed amendments "will not change [plaintiff's] burden of proof," and that it was justified in waiting to seek leave to amend because it was "unclear" in May 2008 whether plaintiff's yet-to-be-filed motion to join and recaption would be granted. In any event, defendant recognizes that further extensions or delays will not be permitted, and that reopening the discovery period would be inappropriate.

Decision

Under Fed. R. Civ. P. 15(a), leave to amend a pleading "shall be freely given when justice so requires." Accordingly, the Board is generally liberal in granting leave to amend pleadings, "unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." International Finance Corp. v. Bravo Co., 64 USPQ2d 1597, 1604 (TTAB

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2002). As held in International Finance Corp., a motion for leave to amend

should be filed as soon as any ground for such amendment becomes apparent. Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion.

Id.; see also, Trek Bicycle Corp. v. StyleTrek Ltd., 64 USPQ2d 1540, 1541-42 (TTAB 2001).

In this case, defendant's motion is untimely. Defendant was on notice that plaintiff would be required to establish its priority date through evidence of use at least as early as May 19, 2008, and should have moved promptly after that date, if not well beforehand, to amend its answers. Similarly, defendant should have known its claimed date of first use long ago. The office action response in application Serial No. 79059290, while recent, was not filed by plaintiff, but instead a nonparty (which defendant opposed joining in this proceeding), and the fact that the response was signed by the same attorneys representing plaintiff in this proceeding is not relevant. In any event, defendant's operative answers already deny the salient allegations in the notices of opposition and petitions for cancellation, and defendant itself "believes that its denial of [plaintiff's] priority and likelihood of confusion claims in the prior Answers filed in these

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proceedings are sufficient to place the burden on [plaintiff] to establish prior use and ownership of a protectable mark." Motion for Leave to Amend at p. 2 n. 2. Therefore, defendant has not shown that the proposed amendments are necessary, even if they were timely and otherwise appropriate, which they are not.²

Allowing leave to amend would also prejudice plaintiff, including because discovery and plaintiff's testimony period are closed. International Finance Corp., 64 USPQ2d at 1604. Therefore, defendant's reliance on Am. Optical Corp. v. Am. Olean Tile Co., Inc., 168 USPQ 471 (TTAB 1971) and Space Base, Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990) is misplaced. Indeed, in Am. Optical it was "adjudged that opposer would not be prejudiced by entry of the amended pleadings if leave were given to it to take discovery," 168 USPQ at 473 (emphasis supplied) and similarly in Space Base, leave to amend was allowed "since any prejudice suffered by applicant could be mitigated by a reopening of discovery solely for applicant's benefit." Space Base, 17 USPQ2d at 1217 n. 1 (emphasis supplied). As defendant specifically recognizes, and the Board has previously held on multiple occasions, reopening either

² Defendant's claim that it did not seek leave to amend promptly after the May 19, 2008 order because it was unclear whether plaintiff's yet-to-be-filed motion to join would be granted cannot be accepted. The record in these proceedings contains no evidence of clairvoyance.

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discovery or the testimony periods in these 10 and 15 year old cases would be inappropriate.

Finally, even if defendant established that plaintiff does not need discovery regarding the distinctiveness of its own marks, defendant does not and cannot argue that plaintiff should not have discovery on defendant's newly-claimed date of first use. Yet defendant seeks leave to plead that plaintiff "cannot establish that its marks acquired distinctiveness before [defendant's newly-claimed] 1977 date of first use" (emphasis supplied). The prejudice to plaintiff is clear.

Conclusion

For all of these reasons, defendant's motion for leave to amend is hereby **DENIED**. Trial dates remain as previously set.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.p
df](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf)

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242 F
inalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the

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Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>
